

BERNHARD MUSSIG
USSN 09/156,886
REPLY TO OFFICE ACTION DATED MAY 15, 2003
REQUEST FOR RECONSIDERATION OF November 15, 2003

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicant respectfully requests that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Applicant respectfully requests reconsideration and allowance of this application in view of the following comments.

At the outset, Applicant acknowledges with appreciation the Examiner's indication that a number of objections and rejections have been overcome and, therefore, are withdrawn.

The sole remaining issue is the rejection of claims 37-55 under 35 USC § 103(a) as being obvious over Koga et al. ("Koga"), EP 661 364, in view of Dobashi et al. ("Dobashi"), US 5,643,676. In response, Applicant respectfully requests that the Examiner reconsider and

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withdraw this rejection.

The Examiner concedes that Koga does not teach the criticality of the diene component when he states that "the dienes comprise 0-50% by weight of the adhesive layer (emphasis added.)" The Examiner also concedes that Koga is "silent as to using the protective film for protecting the paint finish of a vehicle."

Accordingly, the issues, insofar as obviousness is concerned are two-fold: First, has Applicant demonstrated the criticality of the diene component? Second, even assuming for the sake of argument that Koga suggested Applicant's film, is there anything in the combination of references that would have suggested the surprising results obtained when utilizing Applicant's protective film to protect the paint finish of a vehicle?

As to the first issue, the criticality of the diene component has, indeed, been demonstrated. Inventive examples 1-4 all show a variety of propene/ethylene copolymers that *include an amount of a diene*, namely 5-ethylidene-2-norbornene. In contrast, comparison example 3 describes a propene/ethylene copolymer and comparison examples 1, 2 and 4 show other multiple α -olefin copolymers, but *in each case without any diene*. The data show that *every time* the diene is omitted, i.e., in *all* of the comparison examples, there are "severe paint deformations" or, in the case of comparison example 2, a failure to bond sufficiently. In

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contrast, in each of the inventive examples, irrespective of the fact that the propene/ethylene ratio was varied, *there were no defects*. Applicant submits that this data clearly shows the criticality of including the diene component. A person having ordinary skill in the art would have been reasonable to expect, given this data, that the inclusion of the diene component confers an advantage. As Koga teaches the diene component is optional, the proof that the diene component confers an advantage must be regarded as surprising, and, therefore, unexpected, and, consequently, the data are objective evidence of nonobviousness.

As to the second issue, Applicant submits that there is absolutely nothing in Dobashi alone or in its combination with Koga that suggests that a protective film meeting the terms of the present claims should be any better at protecting the paint finish of a vehicle than a protective film not meeting the terms of the claims. Accordingly, Applicant's showing that the protective film meeting the terms of the present claims is, in fact, better at protecting the paint finish of a vehicle than other similar protective films is a surprising and unexpected result, which is, therefore, also objective evidence of nonobviousness.

Applicant would remind the Examiner that his cited combination of references at best establishes only a *prima facie* case of obviousness, and, further, that he has not demonstrated the existence in the prior art of a protective film actually meeting the terms of the instant claims, or its use to protect the paint finish of a vehicle. Accordingly, in order to achieve the present

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invention, a person having ordinary skill in the art must first have found it obvious to make a protective film meeting the terms of the present claims, and second have found it obvious to use the film to protect the paint finish of a vehicle, and third, because Applicant has demonstrated improved results, have had an expectation that improved results would have been achieved. Applicant does not believe the first requirement is satisfied because Applicant has proven the criticality of the diene component. However, even if the first requirement is satisfied, certainly the third requirement is not satisfied because nothing in Dobashi suggests that the hypothetical protective film derived from Koga should be any better at protecting the paint finish of a vehicle than any other similar protective film. Consequently, in the end, the present invention clearly is nonobvious.

The Examiner finds that:

“[O]ne of ordinary skill in the art at the time the invention was made would *have readily appreciated using* the protective film taught by Koga et al. to protect the paint finish of a vehicle as it was well known in the art to use protective films such as those taught by Koga et al. to protect the paint finish of a vehicle from corrosion, dust, deposition, or damage during transport or storage as shown for example by Dobashi et al. [Emphasis Added.]”

In response, Applicant points out that “readily appreciating” is not the proper standard for

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obvious. Instead, there must be a suggestion to carry out the claimed invention coupled with a reasonable expectation of success in so carrying out the claimed invention.

However, even if were true that Dobashi would have suggested to a person having ordinary skill in the art that Koga's protective film would have been useful to protect the finish of a vehicle—which Applicant does not concede—the combination still would not have suggested that the instant protective film would be any better at protecting the finish of a vehicle than would other similar protective films. Consequently, Applicant submits again that the data of record proves an unexpected result.

With respect to the data of record, the Examiner says:

"The table submitted in paper #16 * * * does not show unexpected results as the inventive examples 1-4 differ from the comparison examples 1-3 and 5 in that while the inventive examples do not contain 75 mol% or more of any single α -olefin, the inventive examples also contain a diene component that is not present in the comparative examples. It is unclear whether the unexpected results obtained by the inventive examples are due to limiting the adhesive composition from containing 75 mol% or more of any single α -olefin or to including a diene component."

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However, Applicant points out that the instant claims require a *combination* of both a) less than 75 mol% of any single α -olefin *and* b) a diene component. Consequently, Applicant does not believe that it is necessary for the Examiner to be able to ascertain from the data whether the unexpected result is due to one part of the combination or the other. It is sufficient that the unexpected results are demonstrated to be due to the combination that is claimed.

In further support of his position that the data in the specification do not evidence an unexpected result, the Examiner says "[t]his is further evidenced by comparative example 4 wherein the adhesive composition does not contain 75 mol% or more of any single α -olefin and the adhesive composition does not contain a diene component yet the protective film creates defects in the paint." In response, Applicant is unclear what point the Examiner is attempting to make. The fact that comparative example 4 shows that defects were created in the paint supports Applicant's position that you need both a) less than 75 mol% of any single α -olefin *and* b) a diene component to avoid such damage.

Respectfully, Applicant submits that the Examiner would be fully justified to reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Applicant believes that the foregoing constitutes a bona fide response to all outstanding

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objections and rejections.

Applicant also believes that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Request for Reconsideration under 37 CFR § 1.111 and the accompanying Petition for Extension of Time (10 pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: November 15, 2003

By:

Kurt G. Briscoe